

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 1-34 are pending. Claims 1-4, 12-13, 26-28 and 33-34 were examined. Non-elected claims 5-11, 14-25 and 29-32 were withdrawn from consideration by the Examiner. Rejoinder of the withdrawn claims is requested upon an indication that an elected claim(s) is allowable.

The amendments are fully supported by the original disclosure and, thus, no new matter has been added. For example, support for cholera-toxin negative (ChTx-) cells is at page 6, lines 8-20, of the specification.

The priority claim is updated by referring to the serial number and filing date of the international patent application. The filing date of the provisional patent application is corrected.

Double Patenting and Novelty

Claims 1-4, 12-13, 26-28 and 33-34 were rejected for alleged obviousness-type double patenting over claims 14 and 16 of U.S. Patent No. 5,753,491 (the '491 patent), and under 35 U.S.C. § 102(e) over both the '491 patent and U.S. Patent No. 5,750,376. Applicants traverse.

The cited references do not teach that the multipotent cells utilized were cholera-toxin negative (ChTx-) cells. The Patent Office's position that the references "inherently express markers that uniquely define what constitutes a multipotent stem cell" is not well taken. Multipotent stem cells can be either cholera-toxin negative or cholera-toxin positive. Therefore, cholera-toxin negative status is not an inherent characteristic of multipotent cells. "Inherency . . . may not be established by probabilities or possibilities." (*Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991), quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)). The burden is on the Patent Office to cite evidence that the allegedly inherent limitation is necessarily present in the prior art reference, not on Applicants to prove otherwise.

Withdrawal of the double patenting and Section 102 rejections is requested.


Conclusion

Having fully responded to all of the pending objections and rejections contained in this Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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